REMARKS/ARGUMENTS

Claims 1-35 were originally presented for examination. Claims 1, 13, 14, 20, 22, 23, 31, and 32 have been amended herein. Also, Claims 36 & 37 are added to claim additional novel aspects of the invention. Accordingly, **Claims 1-37 are now pending in this application.** Certain informalities and inconsistencies in the claims have also been corrected. No new matter has been added. Reconsideration and allowance are respectfully requested.

Claim Rejections Under 35 U.S.C. §102:

Claims 1, 2, 8, 11-15, 19-24, 28, 31, and 33 stand rejected under 35 U.S.C. §102(e) as being anticipated by the U.S. Patent to *Logan* (USPN 6,601,018). The applicants call attention to the fact that *Logan* is directed to an invention "for test execution" of software in "the context of an automatic test framework" (e.g., *Logan*, Abstract). The applicants also point out that that *Logan* is a test procedure whereby programs are "tested" to confirm that they are operational (*Logan* at 11:65-66). This is different from the component verification process claimed in the present invention. By way of example, Claim 1 does not require the test execution "of the at least one software component of the package" as would be required by *Logan*.

The applicants respectfully point out that *Logan* requires the reading of component code (of the components of the software package) and requires a test case code generator which operates on executable code of the package components in order to test the components (*Logan* e.g., at 2: 19-29). This is a laborious and time consuming process which is also significantly different from the teachings of the present invention which does not require the execution of code in the components of the package in order to verify the package. Thus, the present invention represents a substantial increase in speed and efficiency.

Additionally, *Logan* teaches, as critical, the need to reduce the amount of hand coding done to generate test sections. This attribute, described as so vital in Logan, is simply irrelevant to the present invention.

Also, importantly, *Logan* teaches a very narrow invention. *Logan*, in it broadest interpretation, requires "reading an executable file of a component, including a class file of a JavaBean component, **executing a test case code generator** automatically on the executable file, and generating a skeleton test suite as a base for an individualized test case of the component, the test execution means utilizing an introspection facility of Java for the executing" (e.g., see *Logan* Claim 1). None of these elements, so basic to *Logan*, are at issue in the claimed invention. The disclosed invention is not confined to this very narrow application as described in *Logan*.

The following discussion makes more clear the distinction between the present invention and the cited art. Applicants now discuss the individual grounds of rejection.

Claims 1, 2, 8, 11, & 12

Claim 1 stands rejected under 35 U.S.C. §102(e) as being anticipated by the U.S. Patent to *Logan*. Claim 1 has been amended and now recites: a software package that includes "a file list having data entries associated with parameters for the at least one software component" and recites test modules "configured to use the data entries of the file list to test at least one parameter of the software package". *Logan* does not use data entries in a file list to test the software components to verify the software package. In contrast, *Logan* requires the execution of at least portions of executable code of software components of the package in order to accomplish testing. Such is not the case in Claim 1, which only requires a cursory examination of the data contained in a file list entry in order to verify a component of a software package. The advantages of speed and simplicity involved in such an approach are self-evident. Therefore, applicants respectfully request that this ground of rejection be withdrawn as to Claim 1. Additionally, for at least the same reasons as given above with respect to Claim 1, the applicants respectfully request that this ground of rejection be withdrawn as to dependent **Claims 2, 8, 11, and 12.**

Claim 13

Independent **Claim 13** is also rejected under 35 U.S.C. §102(e) as being anticipated by the U.S. Patent to *Logan*. As amended, Claim 13 now recites: a software package that includes "a file list having data entries associated with parameters for the at least one software component" and recites "providing at least one test module configured to use the data entries of the file list to test at least one parameter of the software package". This is again in contrast with the testing process of *Logan* which requires the execution of the code of software components of the package in order to accomplish testing. As with Claim 1, Claim 13 also only requires a cursory examination of data contained in a file list entry in order to verify a component of a software package. Therefore, applicants respectfully request that this ground of rejection be withdrawn as to Claim 13.

Claims 14, 15, & 19

Claim 14 also stands rejected under 35 U.S.C. §102(e) as being anticipated by the U.S. Patent to *Logan*. Many of the same shortcomings of *Logan* pointed out with respect to Claim 1 are similarly applicable to Claim 14. As amended Claim 14 recites a software package that includes "a file list having data entries associated with parameters for the at least one software component" and includes a "framework for identifying at least one test module" wherein each test module is "configured to use the data entries of the file list to test the at least one parameter of the software package". This is in contrast to the testing process of *Logan* which requires the execution of executable code of software components of the package in order to accomplish testing. Such is not the case in Claim 14 which only requires a cursory examination of data contained in a file list entry in order to verify a component of a software package. Therefore, applicants respectfully request that this ground of rejection be withdrawn as to amended Claim 14. Additionally, for at least the same reasons as given above with respect to Claim 14, the applicants respectfully request that this ground of rejection be withdrawn as to dependent **Claims 15 and 19.**

Claims 20 & 21

Claim 20 stands rejected under 35 U.S.C. §102(e) as being anticipated by the U.S. Patent to *Logan*. Many of the same shortcomings of Logan pointed out with respect to Claim 1 are similarly applicable to Claim 20. In particular, amended Claim 20 recites a software package that includes "file list having data entries associated with parameters for the at least one software component" and includes a "at least one test module configured to use the data entries of the file list to test at least one parameter of the software package" wherein the control module controls the tests that are to be performed. As mentioned above, *Logan* does not use data entries in a file list to test the software components to verify the software package. *Logan* requires the execution of executable code of software components of the package in order to accomplish testing. Such is not the case in Claim 20 which only requires a cursory examination of data contained in a file list entry in order to verify a component of a software package. Therefore, applicants respectfully request that this ground of rejection be withdrawn as to Claim 20. Additionally, for at least the same reasons as given above with respect to Claim 20, the applicants respectfully request that this ground of rejection be withdrawn as to dependent **Claim 21.**

Claim 22

Claim 22 stands rejected under 35 U.S.C. §102(e) as being anticipated by the U.S. Patent to *Logan*. Claim 22 now recites a method operating on a software package that includes "a file

list having data entries associated with parameters for the at least one software component" and recites "providing a framework for identifying at least one test module" wherein each test module is "configured to use the data entries of the file list to test at least one parameter of the software package thereby defining a test of at least one parameter of the at least one software component of the package". This is again in contrast with the testing methods of *Logan* which require the execution of the code of software components of the package in order to accomplish testing. As with Claim 1, Claim 22 also only requires a cursory examination of data contained in a file list entry in order to verify a component of a software package. Therefore, the applicants respectfully submit that this ground of rejection should be withdrawn as to Claim 22.

Claims 23, 24, & 28

Claim 23 also stands rejected under 35 U.S.C. §102(e) as being anticipated by the U.S. Patent to *Logan*. Many of the same shortcomings of *Logan* pointed out with respect to Claim 1 are similarly applicable to Claim 23. As amended Claim 23 now recites a method for verifying a software package that includes "a file list having data entries associated with parameters for the at least one software component" and recites a step of "providing a framework for identifying at least one test module" wherein each "test module configured to use the data entries of the file list to test at least one parameter of the software package thereby defining a test of at least one parameter of the at least one software component of the package". Again in contrast, the testing of *Logan* requires the execution of executable code of software components of the package in order to accomplish testing. Such is not the case in Claim 23 which only requires a cursory examination of data contained in a file list entry in order to verify a component of a software package (e.g., "use the data entries of the file list to test at least one parameter of the software package"). Therefore, applicants respectfully request that this ground of rejection be withdrawn as to Claim 23. Additionally, for at least the same reasons as given above with respect to Claim 23, the applicants respectfully request that this ground of rejection be withdrawn as to dependent **Claims 24 and 28.**

Claim 31

Claim 31 stands rejected under 35 U.S.C. §102(e) as being anticipated by the U.S. Patent to *Logan*. Claim 31 now recites: a software package that includes the step of receiving a software package that "includes a file list having data entries associated with parameters for the at least one software component". *Logan* does not teach this. Claim 31 also recites accessing a framework "that references at least one test module to identify the at least one test module from

the framework" wherein the test modules are configured to use the data entries of the file list to define a test of the software package". *Logan* does not teach this. Tests in accordance with the claimed invention are performed using data entries of the file list to define a test of the software package. *Logan* does not teach this. Also, the testing process of *Logan* requires the execution of the code of software components of the package in order to accomplish testing. For at least these reasons, *Logan* is a deficient reference as to establishing anticipation of Claim 31. Therefore, applicants respectfully request that this ground of rejection be withdrawn as to amended Claim 31.

Claim 33

Claim 33 is believed to stand rejected under 35 U.S.C. §102(e) as being anticipated by the U.S. Patent to *Logan* (See, page 2 of the Office Action). The Office Action fails to particularly identify any specific portions of the *Logan* reference that anticipate Claim 33. In particular, it is respectfully submitted that Logan does not teach "a first field containing data representing one of a plurality of test modules, each test module being operable to test of at least one parameter of the at least one software component of the package" nor does it teach that the "data representing ones of the test modules may be added to and deleted from the data structure, creating a flexible data structure". At least absent these teachings, *Logan* is insufficient to establish anticipation of Claim 33. Therefore, applicants respectfully request that this ground of rejection be withdrawn as to Claim 33.

Claim Rejections Under 35 U.S.C. §103:

Claims 3-7, 9, 10, 16-18, 25-27, 30, 32, 34, and 35 have been rejected under 35 U. S. C. § 103(a) as being unpatentable over *Logan,* in view of, *Mastronardi* (USPN 6,346,951).

As to **Claim 3**, *Logan* is deficient for at least the reasons expressed above with respect to Claim 1. *Logan* at least does not teach "a file list having data entries associated with parameters for the at least one software component" and recites test modules "configured to use the data entries of the file list to test at least one parameter of the software package". Thus, *Logan* does not use data entries in a file list to test the software components to verify the software package. Moreover, *Mastronardi* is similarly deficient because it does not teach or suggest using test modules "configured to use the data entries of the file list to test at least one parameter of the software package". Thus, it is respectfully submitted that the cited the *Logan* and *Mastronardi* references, alone or in combination, fail to establish a prima facie case of obviousness as to Claim 3. Accordingly, applicants respectfully request that this ground of rejection be withdrawn as to Claim 3.

As to **Claim 4**, Logan is deficient for at least the reasons expressed above with respect to Claim 1. *Logan* at least does not teach "a file list having data entries associated with parameters for the at least one software component" and recites test modules "configured to use the data entries of the file list to test at least one parameter of the software package". Thus, *Logan* does not use data entries in a file list to test the software components to verify the software package. Moreover, *Mastronardi* is similarly deficient because it does not teach or suggest using test modules "configured to use the data entries of the file list to test at least one parameter of the software package".

Additionally, the Office Action submits that it "would have been obvious" to modify the framework of Logan by using the priority test of *Mastronardi*. First it is not believed that *Mastronardi* teaches any testing of a priority <u>of execution</u> for test modules. Secondly, even if such testing was taught by *Mastronardi*, such combination of *Mastronardi* with *Logan* is improper absent some the some suggestion of the desirability of doing what the inventor has done. The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. The MPEP states that "[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985))(MPEP 2142). If (as is the case here), the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986)(MPEP 2142). In the present case, the Office Action has not satisfactorily explained why the suggested combination is proper. The sole rationale for combining the references, states "it would have been obvious to one skilled in the art at the time the invention was made to modify the automatic software component test framework of *Logan* with the testing priority of *Mastronardi*". ***This line of reasoning is expressly forbidden by the case law.*** "The level of skill in the art cannot be relied upon to provide the suggestion to combine references." *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999 (MPEP 2143..01). "A statement that modifications of the prior art to meet the claimed invention would have been " <u>'well within the ordinary skill of the art</u> at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective

reason to combine the teachings of the references." *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)(emphasis original). Consequently, it is submitted that there is no suggestion in any of the cited references indicating that they should be combined. Thus, it is respectfully submitted that the cited the *Logan* and *Mastronardi* references, alone or in combination, fail to establish a prima facie case of obviousness as to Claim 4. Accordingly, applicants respectfully request that this ground of rejection be withdrawn as to Claim 4.

As to **Claims 5, 6, and 7,** *Logan* is deficient for at least the reasons expressed above with respect to Claim 1. Using **Claim 5** for example, *Logan* at least does not teach "a file list having data entries associated with parameters for the at least one software component" and recites test modules "configured to use the data entries of the file list to test at least one parameter of the software package". Thus, *Logan* does not use data entries in a file list to test the software components to verify the software package. Moreover, *Mastronardi* is similarly deficient because it does not teach or suggest using test modules "configured to use the data entries of the file list to test at least one parameter of the software package". Additionally, and importantly *Mastronardi* does not teach "identifying the at least one **test module** as being one of active and not active". Referring to the cited portion of *Mastronardi* (at 8:24-31), it is clear that determination of active/not-active is being applied to the system being tested (e.g., the video task of *Mastronardi at* 8:26-27) not to the test module itself. Thus, *Mastronardi* does not teach this claim limitation. Thus, it is respectfully submitted that the cited the *Logan* and *Mastronardi* references, alone or in combination, fail to establish a prima facie case of obviousness as to Claim 5. Moreover, for at least the reasons given in support of Claim 5, it is respectfully submitted that cited references fail to establish a *prima facie* case of obviousness as to dependent Claims 6 and 7. Accordingly, applicants request that this grounds for rejection be withdrawn as to **Claims 5, 6, and 7.**

Claims 9 & 10 stand rejected under 35 U. S. C. § 103(a) as being unpatentable over *Logan,* in view of, *Mastronardi.* Here also, *Logan* is deficient for at least the reasons expressed above with respect to Claims 1 and 8. Moreover, *Mastronardi* is similarly deficient because it does not teach or suggest using test modules "configured to use the data entries of the file list to test at least one parameter of the software package". Thus, for at least these reasons, the cited references fail to establish a *prima facie* case of obviousness as to Claims 9 and 10. Accordingly, applicants request that this ground for rejection be withdrawn as to **Claims 9& 10.**

Claim 16 stands rejected under 35 U. S. C. § 103(a) as being unpatentable over *Logan,* in view of, *Mastronardi.* Here also, *Logan* is deficient for at least the reasons expressed above with

respect to Claims 14 and 15. Moreover, *Mastronardi* is similarly deficient because it does not teach or suggest using test modules "configured to use the data entries of the file list to test at least one parameter of the software package". Thus, for at least these reasons, the cited references fail to establish a *prima facie* case of obviousness as to Claim 16. Accordingly, applicants request that this grounds for rejection be withdrawn as to **Claim 16.**

As to **Claim 18,** *Logan* is deficient for at least the reasons expressed above with respect to Claims 14 & 15. For example, *Logan* at least does not teach "a file list having data entries associated with parameters for the at least one software component" and recites test modules "configured to use the data entries of the file list to test at least one parameter of the software package". Thus, *Logan* does not use data entries in a file list to test the software components to verify the software package. Moreover, *Mastronardi* is similarly deficient because it does not teach or suggest using test modules "configured to use the data entries of the file list to test at least one parameter of the software package". Additionally, and importantly Mastronardi does not teach "identifying the at least one test module as being one of active and not active". Again, referring to the cited portion of *Mastronardi* (at 8:24-31), it is clear that determination of active/not-active is being applied to the system being tested (e.g., the video task of *Mastronardi at* 8:26-27) not to the test module itself. Thus, *Mastronardi* does not teach this claim limitation. Thus, it is respectfully submitted that the cited the *Logan* and *Mastronardi* references, alone or in combination, fail to establish a prima facie case of obviousness as to Claim 18. Accordingly, applicants request that this grounds for rejection be withdrawn as to Claim 18.

As to **Claims 25, 26, and 27,** *Logan* is deficient for at least the reasons expressed above with respect to Claims 23 and 24. Using **Claim 25** for example, *Logan* at least does not teach "a file list having data entries associated with parameters for the at least one software component" and also does not teach a step of "providing a framework for identifying at least one test module" wherein each "test module configured to use the data entries of the file list to test at least one parameter of the software package thereby defining a test of at least one parameter of the at least one software component of the package". Thus, *Logan* does not use data entries in a file list to test the software components to verify the software package. Moreover, *Mastronardi* is similarly deficient because it does not teach or suggest using test modules "configured to use the data entries of the file list to test at least one parameter of the software package". Moreover, as to Claim 27, Mastronardi does not teach "identifying the at least one **test module** as being one of active and not active". Referring to the cited portion of *Mastronardi* (at 8:24-31) it is clear that determination of active/not-active is being applied to the system being tested (e.g., the video task of *Mastronardi at* 8:26-27) not to the test module itself. Thus, *Mastronardi* does not teach this

claim limitation. Thus, it is respectfully submitted that the cited the *Logan* and *Mastronardi* references, alone or in combination, fail to establish a prima facie case of obviousness as to Claims 25 and 27. The same can be said for dependent Claim 26. Accordingly, applicants request that this grounds for rejection be withdrawn as to **Claims 25, 26, and 27**.

As to **Claims 29 & 30**, *Logan* is deficient for at least the reasons expressed above with respect to Claims 23, 24, and 28. For example, *Logan* at least does not teach "a file list having data entries associated with parameters for the at least one software component" and also does not teach a step of "providing a framework for identifying at least one test module" wherein each "test module configured to use the data entries of the file list to test at least one parameter of the software package thereby defining a test of at least one parameter of the at least one software component of the package". *Mastronardi* is similarly deficient because it does not teach or suggest using test modules "configured to use the data entries of the file list to test at least one parameter of the software package". Thus, for at least the reasons advanced with respect to Claims 23, 24, and 28, it is respectfully submitted that the cited the *Logan* and *Mastronardi* references, alone or in combination, fail to establish a prima facie case of obviousness as to Claims 29 & 30 and, therefore, applicants request that this grounds for rejection be withdrawn as to **Claims 29 & 30.**

Claim 32 is amended to correct a typographical error. As to the substantive rejection of **Claim 32**, *Logan* is deficient for at least the reasons expressed above with respect to Claim 31. As with Claim 31, *Logan* does not teach a software package that includes the step of receiving a software package that "includes a file list having data entries associated with parameters for the at least one software component". Nor does *Logan* teach "that references at least one test module to identify the at least one test module from the framework" wherein the test modules are configured to use the data entries of the file list to define a test of the software package". Nor does *Logan* teach tests performed using data entries of the file list to define a test of the software package. Also, the testing process of *Logan* requires the execution of the code of software components of the package in order to accomplish testing. Because Logan does not teach these fundamental steps of the claimed invention it cannot also teach repeating such steps as required in Claim 32. Moreover, there is no teaching in *Mastronardi* that addresses repeatedly accessing the framework to access tests in their relative priority. Thus, it is respectfully submitted that the cited the *Logan* and *Mastronardi* references, alone or in combination, fail to establish a prima facie case of obviousness as to Claim 32. Accordingly, applicants request that this grounds for rejection be withdrawn as to Claim 32.

As to **Claims 34 & 35**, *Logan* is deficient for at least the reasons expressed above with respect to Claim 33. In other words the reasons for rejecting Claim 33 on the bases of *Logan* was not supplied in the Office Action. For example, *Logan* at least does not teach "a first field containing data representing one of a plurality of test modules, each test module being operable to test of at least one parameter of the at least one software component of the package" nor does it teach that the "data representing ones of the test modules may be added to and deleted from the data structure, creating a flexible data structure". Thus, for at least the reasons advanced with respect to Claim 33, it is respectfully submitted that the cited the *Logan* and *Mastronardi* references, alone or in combination, fail to establish a prima facie case of obviousness as to Claims 34 & 35. Moreover, the cited art does not teach a "second data field identifying a priority for each of the test modules" (Claim 34) or a "third data field identifying the one of the plurality of test modules ... as being one of active and not active" (Claim 35). Therefore, applicants respectfully submit that that this grounds for rejection should be withdrawn.

Added Claims:

The applicants have added **Claim 36**, which is directed specifically to a Solaris platform. Support for this amendment can be found in the Specification, for example, at page 9: lines 3-10. The cited art does not address Solaris compatible configurations. Therefore, for at least that reason, it is respectfully submitted that Claim 36 should be allowable.

The applicants have added **Claim 37**, which is directed to a file list comprising a "pkgmap" file or other similar file. The cited art does not address such a "pkgmap" and, therefore, for at least that reason, it is respectfully submitted that Claim 37 should be allowable.

CONCLUSION

Applicants respectfully submit that based on the amendments and remarks advanced herein that all pending claims are in condition for allowance and therefore respectfully request a Notice of Allowance for this application from the Examiner. If the Examiner wishes to telephone the applicants attorney concerning any matter pertaining to this application, he is cordially invited to do so at his earliest convenience using the telephone number set forth below.

Respectfully submitted,
BEYER WEAVER & THOMAS, LLP

Francis T. Kalinski II
Registration No. 44,177

P.O. Box 778
Berkeley, CA 94704-0778
(650) 961-8300